

REMARKS

This letter is responsive to the final office action mailed August 4, 2009.

Claims 1, 7-14, 23, 29-36, 45 and 46 remain pending in the application. Claims 1, 23 and 45 are independent.

The Examiner has withdrawn the rejection under 35 U.S.C. §112. Accordingly, the only rejection that remains outstanding is made under 35 U.S.C. §103, as noted below.

Claims 1, 7-14, 23, 27-36, 45 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,216,072 issued to Kasai et al. (hereinafter "Kasai"). Applicants respectfully traverse all rejections.

At page 3 of the office action, the Examiner concedes that the present rejection relies on a single reference, which discloses multiple embodiments, and the knowledge generally available to one of ordinary skill in the art. The Examiner further concedes that the obviousness arguments are based mainly on the first and the fourth embodiments of Kasai.

However, in Applicants' response dated April 7, 2009, at least at page 12 (last paragraph) and page 13, the Applicants highlighted evidence in Kasai that those embodiments specifically **teach away** from the subject matter of Applicants' claims. The Examiner failed to respond to those arguments and evidence in the final office action.

The Examiner is respectfully reminded that, as set forth in MPEP 2141.03 VI, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention: *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The Examiner is not entitled to rely only upon certain teachings in a reference, while ignoring other teachings **within the same single reference** that would lead away from the claimed subject matter. The Applicants respectfully submit that it is improper to simply rely on "general knowledge" to modify selected features of selected embodiments, when there is clear evidence of "teaching away" within that single reference.

As noted at page 13 of Applicants' previous response, in a system where the translation server 33 requires input to also be in HTML format, if e-mails were sent in HTML format, this would render the purported "format conversion" functions of the translation mail server 32 useless. It is unlikely that the ordinary skilled person would implement such a modification to Kasai that would lead to this result.

Applicants emphasize that the claims do not pre-empt all uses of proxy and processing servers. The claims are only directed to mobile devices and proxies that are to communicate with those processing servers (e.g. a translation server) that require input in HTML. In this particular context, the use of the Applicants' proxy now provides certain advantages not at all contemplated in Kasai. For example, it would now be possible for mobile computer devices to utilize publicly available HTML translation servers. By "piggybacking" off servers in the public domain (i.e. maintained by a third party), the need for certain services to be installed directly on the mobile computer device may be eliminated, and therefore, processing resources and battery life on the mobile computer device may be conserved. This is an unexpected result contemplated only by the Applicants, and not by Kasai.

In view of the foregoing, Applicants submit that the Examiner has failed to provide adequate evidence that the ordinary skilled person would in fact be motivated to modify Kasai, as Kasai teaches away from the modification suggested by the Examiner. Applicants respectfully submit that **claims 1, 7-14, 23, 29-36, 45, and 46** are patentable over Kasai and the other references relied

upon by the Examiner. Withdrawal of the remaining objections under 35 U.S.C. 103 is respectfully requested.

Final Remarks

The Applicants note that the Supreme Court's *KSR* decision¹ did not reject the use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis. The Supreme Court characterized the analysis as a helpful insight. It is respectfully submitted that the absence of a teaching, suggestion or motivation is a significant point in the Applicants' favor, as this absence is indicative of non-obviousness.

Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. In the event that the Examiner chooses to pursue a different avenue for rejection, the Examiner is invited to explicitly identify the rationale and articulate the reasons on which such rejection is based, and it should be noted that any new avenue would be a new ground for rejection not due to any action by the Applicants.

The Applicants further respectfully remind the Examiner that, even after *KSR*, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning; (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness; (4) hindsight has no place in an obviousness analysis; and (5) Applicants are entitled to a careful, thorough, professional examination of the claims (in which

¹ *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007).

Appl. No. 10/772,476
Reply Dated September 30, 2009
Reply to Office Action of August 4, 2009

the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

In view of the foregoing, Applicants submit that each of **claims 1, 7-14, 23, 29-36, 45, and 46** are now in condition for allowance.

Yours truly,

BERESKIN & PARR LLP/S.E.N.C.R.L.,s.r.l.
Agent for the Applicants


Kendrick Lo
Reg. No. 54,948
(416) 364-7311